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EXAMINER

BORSETTI, GREG

ART UNIT	PAPER NUMBER
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2626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,360	Applicant(s) SUGIYAMA ET AL.	
	Examiner GREG A. BORSETTI	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 31-52 and 60-75 are pending.
2. Claims 31-52 have been canceled.
3. Claims 60-75 have been added.
4. Claims 53-59 have been withdrawn and are now considered canceled. Applicant should formally cancel claims 53-59 for consideration in the instant application.
5. All previous rejections have been withdrawn due to the applicant canceling all previous claims.

Response to Arguments

6. Applicant's arguments with respect to claim 60-75 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim(s) 60-63, 65-66 is/are rejected under 35 USC 101 for being nonstatutory. Under the most recent interpretation of the Interim Guidelines regarding 35 U.S.C.101, a method claim must (1) be tied to another statutory class or (2) transform underlying subject matter to a different state or thing. If no transformation occurs, the claim(s) should positively recite the other statutory class to which it is tied to qualify as a

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statutory process under 35 U.S.C. 101. As for guidance to areas of statutory subject matter, see 35 U.S.C. 101 Interim Guidelines (with emphasis of the Clarification of "processes" under 35 USC 101); As an example, the claim(s) could identify the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed. For further clarification, a method not tied to another statutory class and is a nonstatutory claim overall if a human can perform the method. Clearly, a human is capable of reading text to analyze and determine information to be added, adding some information, and output the text. This is done in human editing of text. Claim 61 can be interpreted as a human reading and translating the text. Claim 62 can be interpreted as a human reading it aloud. Claim 63 can be interpreted as a human determining how much to speak given what has been read. Claim 65 can be interpreted as a human asking a question if a target does not respond within a reasonable amount of time. Claim 66 can be interpreted as a human prompting another human.

8. Claim 73 is also non-statutory under the most recent interpretation of the Interim Guidelines regarding 35 U.S.C.101 because although this claim is toward a computer readable medium, as claimed, does not define any structural and functional interrelationship between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized (Warmerdam, 33 F.3d at 1361,31 USPQ2d at 1760; Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035). Examiner notes that as per claim 73, elements such as "computer readable medium" is a necessary structure, however the interrelationships between the

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computer readable medium, the computer, and the analysis process are not positively claimed. The current claim scope states "having" a program for a computer to perform. This is not sufficient under 35 USC 101 because there is no "storage" or "encoding" of the program on the computer-readable medium and further, there is no positive recitation of an execution of the program on a computer.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 66 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood by the Examiner what the voice is answering because the added information is a prompt, not an answer. For the purposes of examination, the claim is interpreted that a voice response to a user is a prompt based on the input, such as a confirmation or additional question requiring an answer from the user.

Claim Objections

10. Claim 62 objected to because of the following informalities: The sentence does not have any punctuation to delimit the subject and the action that is being performed. The examiner suggests "wherein the inputted text to which the information is added is converted to voice and outputted as an audio signal."

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11. Claim 63 is also objected to because the claim is not written in proper English.

The claim should read “wherein the amount of information to be added...”

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 60-64, 66-70, 72-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Gabai et al. (US Patent #6773344 hereinafter Gabai).

As per claim 60, Gabai teaches the method comprising:

analyzing inputted text to determine information to be added (Gabai, column 43, lines 3-19, *...It is preferred, in such cases, that a toy not merely translate but combine its translations with other types of content that is appropriate to the given situation...*)

adding the information to the inputted text (Gabai, column 43, lines 3-19, *...It is preferred, in such cases, that a toy not merely translate but combine its translations with other types of content that is appropriate to the given situation...* Furthermore, column 43, lines 35-50 gives examples, one of which is that the

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user inputs a menu and then toy subsequently explains the cultural significance of the dishes.)

outputting the inputted text to which the information is added. (Gabai, column 53, lines 26-36, ...*Their response includes, but is not limited to sound (including voice)...*)

As per claim 61, claim 60 is incorporated and Gabai teaches:

wherein the inputted text is translation text that is translated from a first language to a second language. (Gabai, column 43, lines 3-19)

As per claim 62, claim 60 is incorporated and Gabai teaches:

wherein the inputted text to which the information is added converts to voice and outputs the voice. (Gabai, column 20, lines 14-36, ...*transfer information to the user through sound (possibly using text-to-speech technology)...*)

As per claim 63, claim 60 is incorporated and Gabai teaches:

wherein amount of the information to be added is determined on the basis of the analysis result. (Gabai, column 43, lines 44-50, ...*translating an ancient inscription a toy offers its user a historical commentary on the period and the occasion on which it was written and the subjects it concerns...*, There is inherently a determined amount of available additional information because the database stores available additional information in the database that is retrieved based upon the analysis.)

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As per claim 64, claim 60 is incorporated and Gabai teaches:

where the information is prestored corresponding to a keyword.

(Gabai, column 46, lines 40-67, the toy listens for keywords in its analysis to understand the input and produce the appropriate response. Also, example II (columns 45-46) shows that the information is related to the input keywords.)

As per claim 66, claim 62 is incorporated and Gabai teaches:

wherein the information is information for prompting a target for which the voice is output to answer. (Gabai, columns 45-46, Example II, teaches that information is added for prompting a target using voice, column 46, lines 1-5).

As per claim 67, Gabai teaches:

an information changing unit for receiving inputted text (Gabai, column 43, lines 20-34, ...*special scanner*...)

analyzing the inputted text to determine information to be added and adding the information to the inputted text (Gabai, column 43, lines 3-19, ...*It is preferred, in such cases, that a toy not merely translate but combine its translations with other types of content that is appropriate to the given situation*... Furthermore, column 43, lines 35-50 gives examples, one of which is that the user inputs a menu and then toy subsequently explains the cultural significance of the dishes.)

and an information reproducing unit for converting and output from the information changing unit to voice. (Gabai, column 53, lines 26-36, ...*Their*

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response includes, but is not limited to sound (including voice)...)

Claims 68, 69 are rejected for the same reasons as claims 61, 63.

As per claim 70, claim 67 is incorporated and Gabai teaches:

wherein the information changing unit comprises a memory unit for storing the information corresponding to a keyword, extracts the keyword from the inputted text and selects the information stored into the memory unit on the basis of the extracted keyword. (Gabai, column 46, lines 40-67, the toy listens for keywords in its analysis to understand the input and produce the appropriate response. Also, example II (columns 45-46) shows that the information is related to the input keywords.)

Claim 72 is rejected for the same reasons as claims 66.

Claims 73-75 are rejected for similar reasons to claims 60 and 67. Claim 73 is the computer readable medium claim for the method of claim 60. The apparatus in claim 67 has been shown to be a computer based apparatus which inherently has to be programmed and executed from a computer-readable medium. Claims 74-75 are the terminal and server claims for the method and apparatus of claims 60 and 67. Gabai teaches that the toy can use cellular technology which is well known in the art to be able to independently process input as well as process the input through a server.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 65, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US Patent #6773344 hereinafter Gabai) in view of Uwakubo. (US Patent #6513011)

As per claim 65, claim 62 is incorporated and Gabai fails to teach, but Uwakubo teaches:

further comprising analyzing reaction time of a target for which the voice is output (Uwakubo, columns 7-8, lines 63-67 and 1-8, ...*a time period is clocked in some times, from a time when a reaction is presented to the output unit 360 (to the user) to another time when the user starts action in response to the presented reaction...*)

and determining the information on the basis of the analysis result. (Uwakubo, column 8, lines 21-31, ... generate reactions or suspends the generating of the reactions, based on instructions from the conversation manage unit 330... A reaction is generated based upon the reaction time of the user.)

It would have been obvious to someone of ordinary skill in the art at the time of the invention to combine Uwakubo with the Gabai device because “prior devices can

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not follow changes of a length of a pause (timing) in a conversation” (Uwakubo, column 1, lines 38-42) The combination of Uwakubo with the Gabai device would have been obvious to try because it improves smooth information transition and has a reasonable expectation of success.

Claim 71 is rejected for the same reasons as claim 65.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to PTO-892, Notice of References Cited for a listing of analogous art.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREG A. BORSETTI whose telephone number is (571)270-3885. The examiner can normally be reached on Monday - Thursday (8am - 5pm Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHMOND DORVIL can be reached on 571-272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg A. Borsetti/
Examiner, Art Unit 2626

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/Tivaldis Ivars Smits/
Primary Examiner, Art Unit 2626

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